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IN THE

Supreme Court of the United States

October Term, 1965

No. 354

S. W. FARBER, INC.,

Petitioner,

v.

TEXAS INSTRUMENTS, INCORPORATED,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT AND APPENDICES

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P—a	Petitioner's appendix to brief filed in the Court of Appeals
SP—a	Petitioner's supplemental appendix filed in the Court of Appeals
D—b	Respondent's Appendix to brief filed in the Court of Appeals
PX	Petitioner's exhibit
DX	Respondent's exhibit
App. —	Appendix to this Petition

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TEXAS INSTRUMENTS, INCORPORATED,

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

To the Honorable Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Your petitioner, S. W. Farber, Inc., prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Third Circuit entered in this case on April 20, 1965.

Citations to Opinions Below

The first opinion of the District Court, printed in Appendix A hereto, *infra,* pp. 15-29, is reported at 211 F. Supp. 686. The second opinion of the District Court, printed in Appendix B hereto, *infra,* pp. 30-45, is reported at 230 F. Supp. 883. The judgment appealed to the Court of Appeals is printed in Appendix C hereto, *infra,* pp. 46-47.

The opinion of the Court of Appeals, printed in Appendix D hereto, *infra,* p. 48, is reported at 344 F. 2d 957.

Jurisdiction

The judgment of the Court of Appeals was entered on April 20, 1965, Appendix E, p. 49, *infra.* The jurisdiction of this Court is invoked under 28 U. S. C. Section 1254(1).

Question Presented

In affirming the judgment of the District Court which held petitioner's patent invalid, did the Court of Appeals properly apply the test of patentability set forth in 35 U. S. C. Section 103 to the facts found by the District Court?

Statutory Provisions Involved

Title 35 of the United States Code provides, in its pertinent parts:

"Sec. 101. Inventions Patentable

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title. (R.S. 4886; 35 U.S.C., 1946 ed., 31.)

"Sec. 102. Conditions for patentability; novelty and loss of right to patent

"A person shall be entitled to a patent unless—

"(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States,

* * *

"(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

"(f) he did not himself invent the subject matter sought to be patented,

* * *

"Sec. 103. Conditions for patentability; non-obvious subject matter

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences be-

tween the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

"**Sec. 282. Presumption of validity; defenses**

"A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

"The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

* * *

"(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

* * *"

Statement

Petitioner is the owner of United States Letters Patent No. 2,926,230 ('230), granted February 23, 1960, in the name of Hoyt K. Foster (Foster), for an invention relating to an improved detachable electrical connector and temperature regulator for electrically controlled heating devices, such as cooking utensils.

The detachable thermostatic connector of the patent serves to connect the heating element of the utensil with a source of electrical power, and, at the same time, thermostatically controls the temperature of the utensil. The

'230 patent describes and illustrates the invention as used with an electrically heated frypan.

The detachable temperature regulating connector of Foster's invention possesses a relatively long thermal element which may be placed well into the heat zone to detect and sense the temperature of the utensil. The relatively long tubular element, being part of the thermostat assembly, is thereby in position to determine the temperature for itself, rather than to have the temperature sent back to it through feelers or conducting wires.

Prior to Foster's invention of the '230 patent, there were two types of thermostatically controlled frypans on the market, neither of which could be completely immersed for washing purposes. One type could not be immersed in water at all. The other type could be immersed only up to a temperature dial on the handle and carried a notice to that effect (App. 32). Foster recognized the desirability of an electrically heated, thermostatically controlled frypan which could be completely immersed in water for washing purposes without damaging the frypan, the electrical heating element or the thermostatic controller. Foster's detachable connector overcame the problem inherent in the two known types of frypan constructions then being marketed and made possible the fully immersible electrified frypan, now a well-known household utensil.

Petitioner brought this action against respondent for infringement of the '230 patent in the District Court for the District of Delaware. Jurisdiction was based upon 28 U. S. C. 1338(a) (App. 31).

In its answer, respondent denied infringement, denied the validity of the '230 patent, and affirmatively alleged that the subject matter of the patent substantially, if not entirely, originated with persons associated with respondent. Respondent also asserted two counterclaims, the first of which sought a declaratory judgment that the '230 patent was invalid and not infringed, or, alternatively, that the invention of the '230 patent was made, in whole or in part, by persons associated with respondent. The second counterclaim alleged acts of unfair competition and sought damages therefor. Jurisdiction of the counterclaims was based upon 28 U. S. C. Sections 2201-2202 and Section 1338, respectively (App. 31).

The District Court held a separate trial on the question of authorship of the invention of the '230 patent and held that the invention claimed by the '230 patent had not been made, in whole or in part, by persons associated with respondent (App. 15-29).

In January, 1964, the District Court held a second trial which dealt with the validity of the '230 patent and the other issues remaining after the District Court's first decision. The parties agreed that Claims 2 and 4 of the patent were typical; that if Claims 2 and 4 are valid, all claims were valid; that if Claims 2 and 4 are invalid, all claims were invalid (App. 31). Respondent admitted infringement if the patent were valid.

The District Court found that,

(1) a need for a fully immersible, electrified frypan existed and the connector of the '230 patent filled

that need by making such a frypan possible (App. 32, 42);

(2) the use of a detachable temperature regulating connector as the means for obtaining the desired result of full immersibility was original with Foster (App. 32);

(3) the specific connector of the '230 patent having a probe for sensing the temperature was also original with Foster (App. 32-34);

(4) the connector of the '230 patent came into widespread use, was adapted by industry, and achieved commercial success (App. 42);*

(5) the function performed by the structure disclosed in the '230 patent was new and useful (App. 41); and

(6) the patent was presumptively valid, and the statutory presumption of validity was enhanced by the fact that the patents relied upon by the Court in invalidating petitioner's patent had been cited in the Patent Office against the '230 patent (App. 42).

Despite these findings, the District Court held the '230 patent invalid under 35 U. S. C. Section 103, because it considered that the differences between the claims of the patent and the prior art were such that the subject matter of the patent, as a whole, would have been obvious to a person having ordinary skill in the art to which the sub-

* Prior to trial, respondent stipulated that "The structure disclosed and claimed in United States Letters Patent No. 2,926,230 has come into widespread use" (P72a).

ject matter of the patent pertained. The Court invalidated the patent solely upon the basis of Section 103 and did not consider the other defenses of invalidity.

The Court granted the first counterclaim to the extent of adjudging the patent invalid, and dismissed, on the merits, the counterclaim alleging unfair competition by petitioner (App. 46-47). No appeal was taken from the dismissal of this counterclaim. In rendering its opinion, the Court incorporated by reference the findings of fact and conclusions of law stated in its first opinion (App. 30-31).

On appeal, petitioner asserted that the District Court had not applied the correct and controlling standard of patentability, set forth in 35 U. S. C. Sections 101 and 103, to the facts found by it. However, the Court of Appeals affirmed, *per curiam*.

Reasons for Granting the Writ

The decision of the Court of Appeals raises an important question of federal law which has not been, but should be, settled by this Court.

Section 103, by its terms, requires three determinations:

(1) what the prior art was;

(2) whether differences exist between the prior art and the subject matter of the patent; and

(3) whether that subject matter, as a whole, would have been obvious to a person having ordinary skill in the art to which the subject matter pertains.

When Section 103 is the only statutory provision under consideration, as is the case here, the Statute provides that an invention is patentable when it has been determined that it is *new, useful,* and *not obvious.*

The *per curiam* opinion of the Court of Appeals does not express that Court's views on the standard of patentability to be applied under Section 103. The standard applied in this case is contained in the District Court's opinion, which the Court of Appeals affirmed.

In its opinion, the District Court, in accordance with Section 103, ascertained what the prior art was and determined that differences existed between the invention of the '230 patent and that prior art (App. 42). It also determined that the invention was "new and useful" (App. 41). The Court concluded, however, that the patent was invalid, because, in its opinion, the subject matter, as a whole, would have been obvious to a person having ordinary skill in the art to which the '230 patent pertains (App. 42).

The Court stated its views on the test of patentability in the following language (App. 41-42):

> "Plaintiff concedes that all of the structural elements found in claims 2 and 4 of the 230 patent were known before Foster conceived of his alleged invention. The conjunction or concert of known elements must contribute something. Only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. This is established doctrine. *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 152 (1950). There, a patent consisting of a combination of me-

chanical elements was held to be invalid because the combination had not resulted 'in any unusual or surprising consequences,' 340 U. S. at 152. The same thing is true of the combination of elements disclosed in claims 2 and 4 of the 230 patent. The Burch thermal element works in precisely the same manner regardless of whether it is in or out of the structure of the 230 patent. It would also work in the same way if it were in the Ross patent.

It may be conceded that the function performed by the structure disclosed in the 230 patent was 'new and useful'. This, however, is not enough to make it patentable. Under 35 *U. S. C.* §101 'invention' or 'discovery' is a prerequisite to patentability. See *Cuno Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 90 (1941) decided under 35 *U. S. C.* §31; *R. S.* §4886, the forerunner of §101 of 35 *U. S. C.* In *Chemical Construction Corp.* v. *Jones & Laughlin Steel Corporation*, 311 F. 2d 367, 371 (3rd Cir. 1962), the Court stated that the *Great Atlantic & Pacific Tea Co., Cuno Engineering Corporation,* and other Supreme Court cases had established a 'high standard' of inventiveness which was required to warrant the issuance of a patent. Claims 2 and 4 fail to meet that standard.

"Plaintiff points out that both the Ross and Burch patents were cited in the Patent Office against the 230 patent but nevertheless the subject matter of 230 was held to be patentable. Admittedly, this enhances the presumption of validity which arose when the patent issued. *Hartford National Bank & Trust Co.* v. *E. F. Drew & Co., Inc.*, 133 F. Supp. 648, 652 (D. Del. 1955), aff'd. 237 F. 2d 594 (3rd Cir. 1956). But this circumstance is not of controlling significance. The standard of inventiveness employed by the patent office is far below that applied by the courts. *Picard* v. *United Aircraft Corporation*, 128 F. 2d 632, 641 (2nd Cir.

1942), cert. den., 317 U. S. 651 (1942). The category of patented unpatentables has been held to be large. *Packwood* v. *Briggs & Stratton Corp.*, 195 F. 2d 971, 974 (3rd Cir. 1952), cert. den. 344 U. S. 844 (1952).

"Plaintiff likewise stresses the fact that the structure disclosed and claimed by Foster has come into widespread use, been adapted by industry, and achieved commercial success. Commercial success, however, without invention will not make patentability. *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp., supra,* p. 153."

In view of the Court's findings as to the novelty, utility and success of the Foster invention, the patent clearly would have been held valid, but for the application of the erroneous standard.

This Court recently has granted petitions for writ of certiorari in the following cases (October 1965 Term):

No. 11, *William T. Graham and Graham Plow, Inc.* v. *John Deere Company of Kansas City and Deere & Company;*

No. 37, *Calmar, Inc.* v. *Cook Chemical Co.;*

No. 43, *Colgate-Palmolive Co.* v. *Cook Chemical Co.;*

No. 55, *United States* v. *Adams, et al.*

All of these cases involve the same question presented by this petition, that is, the proper standard of patentability established by the Patent Act of 1952.

The standard of patentability which has been applied in the present case is markedly similar to the standard of patentability enunciated by the Court of Appeals for the

Eighth Circuit in No. 11, *William T. Graham and Graham Plow, Inc.* v. *John Deere Company of Kansas City and Deere & Company*, which is to be reviewed by this Court. In the *Graham* case, the Court of Appeals for the Eighth Circuit said:

> "Seemingly, the trial court failed to apply the more exacting standard which in our view is implicit in the teachings of the Supreme Court in Cuno Engineering Corporation, supra, 314 U. S. 84, 62 S. Ct. 37 and Great A. & P. Tea Co., supra, 340 U. S. 147, 71 S. Ct. 127, and which we have applied in numerous cases subsequent thereto." 333 F. 2d 529, 534

The similarity between the standard applied by the Eighth Circuit Court of Appeals, in the decision to be reviewed in No. 11, with that applied by the District Court in this case is readily apparent.

The views of the Court of Appeals for the Third Circuit in the present case and the Court of Appeals for the Eighth Circuit in the *Graham* case (No. 11), though apparently in harmony with each other, represent an improper return to the standard of patentability prevailing prior to enactment of the Patent Act of 1952.

The several *amicus curiae* briefs which have been filed in the *Graham* case have presented, in detail, the legislative history of Section 103 of the Act, and, for that reason, this legislative history will not be repeated here. Petitioner submits that this Court, by exercising its corrective jurisdiction in the *Graham* case, will rectify the error committed by the Eighth Circuit Court of Appeals. Since essentially the same question as is presented by this peti-

tion will be considered by the Court in its review of the cases cited above, this petition for writ of certiorari should be granted.

Conclusion

For the foregoing reasons, this petition for writ of certiorari should be granted.

Respectfully submitted,

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Appendix A

Decision—First Trial

UNITED STATES DISTRICT COURT

D. DELAWARE

Civ. A. No. 2271.

Dec. 5, 1962.

STEEL, District Judge.

S. W. Farber, Inc., the plaintiff, sued Texas Instruments, Inc., the defendant, for infringement of U. S. Letters Patent No. 2,926,230 which was issued to plaintiff as assignee of Hoyt K. Foster, the patent applicant. The subject matter of the patent is a detachable temperature regulating connector for an electrically heated device such as a cooking utensil. The combination patent is for the regulating connector itself; the device with which the connector is used is not claimed as a part of the patented combination. The parties have stipulated that a decision with respect to Claim 1 will be dispositive of all other claims.[1]

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1. Claim 1 reads:

"A detachable temperature regulating connector for an electrically heated device comprising in combination a housing, a pair of terminals in said housing for frictional engagement with co-operating terminals on said device, a bracket within said housing, an elongated hollow member carried by said bracket and extending from said housing, said member being formed of a material having a given temperature coefficient of expansion, a pair of electrical contact members affixed to said bracket and connected with at least one of said pair of terminals, a flexible member fixed at one end relative to said bracket and elongated member and extending in a direction generally parallel to said elongated member, the free end of said flexible member being coupled to at least one of said contacts to open and close the contacts when deflected, and a tension member formed of a material having a different temperature coefficient of expansion connecting the distal end of said elongated member with said flexible member at a point between the ends thereof whereby variations in temperature will deflect said flexible member to open and close said contacts."

The plaintiff is incorporated in New York, the defendant in Delaware. Jurisdiction exists under 28 U. S. C. §1338(a).

By virtue of Pretrial Order dated November 27, 1961, the issue before the Court is limited to whether Foster was the sole inventor or whether Burch, or two of defendant's employees, Moorhead or Butts, were joint inventors with Foster.[2] At this juncture it is assumed that the patent is in all other respects valid, since all other defenses have been reserved for later determination, if the defense of joint inventorship should fail.

The plaintiff is engaged in the manufacture and sale of cooking utensils of various kinds. The defendant manufactures and sells thermostats through the Spencer Thermostat Division of its subsidiary Metals & Controls. Neither defendant nor its subsidiary manufactures or sells cooking ware.

Sometime in 1954, Foster, plaintiff's chief engineer, recognized the desirability of developing an electrically heated thermostatically controlled frying pan which could be completely immersed in water for washing. This was not possible with frying pans then on the market because the thermostats were in the handles and could not be detached when the pans were washed. Foster conceived the general idea of solving the problem by putting a probe type of thermostat in a detachable electric plug. Under this general conception a portion of the probe would extend from the plug through a hole midway between the electrical contacts of the plug so as to engage the bottom of the pan and sense its temperature. It was Foster's idea that the action of the thermostat in opening and

2. Defendant's alternative contention, asserted for the first time after trial, that Milton Farber, vice-president of plaintiff, was a joint inventor with plaintiff, is beyond the issue defined by the Pretrial Order.

closing the electrical circuit would keep the pan at predetermined temperature.

Foster's conception did not embrace the use of any particular kind of probe thermostat, although there were several on the market. When the "bulb and bellows" probe type of thermostat which he tried appeared to be unsuitable, he began to look for "a cartridge" type; that is, one cylindrical in shape, less than ½ inch in diameter, and not over 3-4 inches long, for use as a thermal unit in the plug.

On March 31, 1954, Lyndon W. Burch had filed a patent application for a cartridge type thermostat which embodied the "rod and tube" principle.[3] The patent application did not show any specific use to which the thermostat might be put. It simply disclosed a unit which would move in a certain way in response to temperature variation. This application eventuated in Patent No. 2,793,270 which issued to Burch on May 21, 1957.

On October 12, 1954, Burch, having heard from a third party of Foster's desire to obtain a cartridge type thermostat, came to see Foster. Burch showed Foster several models which he had made, and demonstrated them. It was the first time that Foster had seen a cartridge type of thermostat that could be adapted to a removable plug in a cooking utensil, and he thought that it might be what he was looking for. Foster asked Burch about the availability of his thermostat. Burch said that he had already been in contact with Metals & Controls and that it had an option on the thermostat. Foster indicated that he was dubious about utilizing Metals & Controls to make the thermostat because in the past when plaintiff had attempted to work with Metals & Controls, plaintiff had not received a "good reception".

3. The manner in which the rod and tube functioned is not particularly relevant.

On October 13, 1954 Foster wrote a letter to a law firm, Morgan, Finnegan & Durham, enclosing a "sketch and some explanation" of an electric cooking utensil with removable heat control plug dated October 12, 1954. The letter and enclosure set forth the general idea of a detachable plug thermostat for an electric cooking utensil. The thermostat there disclosed was representative only, in a general way, of several types of thermostats that might be used.[4]

On the same day, Foster built what is sometimes referred to as a mock-up or "bread board" model, of an electrical plug which embodied the Burch thermostat. This was simply an experimental design to find out how good the heat control would be for frying pan usage.

On October 14, Foster tested the model by searing and cooking a pot roast. To bring the heat up to the desired level, it was necessary for Foster to make periodic adjustments of the thermal unit. Foster said that apart from enabling him to test how good heat control the Burch thermostat would give, it was "far from being a satisfactory model. It wasn't what you would consider a commercial model".

At about this same time, Burch saw Ottmar, the Vice President and general manager of Spencer Thermostat

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4. On November 30, 1954, Foster filed a patent application, Serial No. 471,949, upon the basis of the disclosures in his letter to his patent attorneys. That application embodied none of the details of the patent in suit.

On September 22, 1955, Foster filed a second patent application, Serial No. 535,797.

On February 10, 1959, Foster filed a third patent application, Serial No. 792,387. This had been divided out of Foster's second application, Serial No. 535,797. It eventuated in the patent in suit, No. 2,926,230 which issued on February 23, 1960.

Foster's first application and the counts of his second application remaining after the filing of the divisional application, are still in the Patent Office.

Division of Metals & Controls, and told him of his meeting with Foster. Burch asked Ottmar whether the defendant would be interested in manufacturing a thermostat for plaintiff. Ottmar was interested and authorized his people to do whatever development work on the thermostat as was necessary. Prior to this, Burch had orally agreed with Ottmar that defendant could have a license under the Burch patent.

Between October 14 and October 22, Farber and Foster discussed the refinements necessary to commercialize the thermostatic control plug as a detachable temperature regulator for a cooking utensil. They recognized that it was wrong to depend on the plastic plug to house the thermostat and to hold it in place, and that a rigid support was needed to keep the probe in alignment with the contacts which opened and closed the electrical circuit and with the adjusting screw. A rigid unitary construction was necessary not only for accuracy of calibration, but to enable the thermal unit to have a small amount of wiggle or play, within the plug. Without the wiggle, it was not possible for the thermal unit to accommodate itself to the "warping" movement of the bottom of the pan which occurred when the pan was heated due to its bi-metallic construction. Furthermore, since plaintiff contemplated that Leviton Manufacturing Company would supply the plug cord and electrical connector and assemble the thermostatic unit in the plug, Farber and Foster knew that unless the sensing tube and the electrical contacts were rigidly held in a fixed position with relationship to each other, shipment of the thermal unit would entail movement between the parts and would not be practical.

On October 22, 1954, Burch brought Lowell Comee from Metals & Controls to the Farber office to meet Farber and Foster. Foster showed Comee and Burch the mock-up model which he had made on October 13 and stated that he

was going to use it as a plug in a device for controlling the heat of a frying pan. Burch asked if he could take the unit back to Metals & Controls so that it could evaluate the unit and see what could be done toward producing one which was commercially practical. With Foster's permission, Comee and Burch took with them the "bread board" model which Foster had built on October 13. Testimony as to other aspects of the meeting is in dispute and will be discussed later.

On November 11, a meeting was held at the Farber plant between Comee, Ottmar, Farber and Foster. Ottmar was a vice president and general manager of Metals & Controls and knew that the plaintiff felt its past experience with the defendant had not been good. Consequently, he devoted himself to attempting to convince Farber that the defendant was the right concern to manufacture the thermal unit for plaintiff. Ottmar said that defendant was building a sample of the thermostat for testing. He and Farber also discussed various business aspects of the matter, costs and so on. Technical discussions took place between Foster and Comee which are discussed in a later portion of the opinion.

On November 17, 1954, Comee and Moorhead, assistant chief engineer of Spencer Thermostat Division, met with Farber and Burch at plaintiff's plant and showed them a thermostat that Metals & Controls had made to see if it would work as plaintiff required. It was shown to them for their criticisms and approval. This model, constructed by Moorhead, was the first physical embodiment of the thermostat which included a bracket interconnecting the probe and electrical contacts so as to create a unitary assembly.

Following this meeting, Butts, another employee of Metals & Controls, made a minor change in the model which Comee and Moorhead had exhibited to Farber and

Foster, consisting of a reversal of the position of the contacts.

On December 2, 1954, Moorhead, Butts and Comee visited plaintiff's plant and showed Farber and Foster a thermostat which incorporated Butts' modification. Defendant had built this thermostat into a cord plug which plaintiff had furnished to it. The thermostat was substantially the bread board model which Foster had given to Burch on October 22, except that, unlike the bread board model, it contained a bracket which interconnected the probe thermal element with the switch contacts and adjusting screw and resulted in a unitary assembly of the entire thermostat. At this conference test runs were made with a frying pan which looked very encouraging.

The design of the unit which defendant submitted to plaintiff on December 2, 1954 was substantially the eventual commercial version of the detachable control plug. Claim 1 of the patent in suit reads on this structure.

On February 10, 1955 plaintiff and defendant entered into a contract under which plaintiff agreed to purchase 100,000 thermostats from defendant during the year 1955 and 150,000 thermostats during the year 1956 on the condition that defendant would manufacture exclusively for plaintiff during these years.

Thereafter thermostats manufactured by defendant were shipped to Leviton Manufacturing Company which supplied complete cord sets and assembled the thermostatic units into the plugs. Leviton then shipped these units to plaintiff which added the knob and decal to the plug. Plaintiff did the final testing. Manufacturing defects began to appear in the thermal unit, and plaintiff finally decided to stop selling thermostats manufactured by defendant and to adopt a substitute made by another manufacturer. At the time, plaintiff had not purchased from defendant either in 1955 or 1956 all of the thermostats which it had agreed to take.

Sometime in 1956, Fred Stern, an employee of the defendant, asked Farber what the plaintiff would do if defendant began to manufacture plug and cord sets like plaintiff's. Farber replied that plaintiff would sue the defendant. When defendant did so the present suit was brought.

A presumption of validity of the Foster patent arose upon its issuance. 35 U. S. C. §282. This presumption, however, is a weak one since the question of joint inventorship was not before the Patent Office. Cf. Dole Refrigerating Co. v. Americo Contact Plate Freezers, 265 F. 2d 627, 629 (3 Cir. 1959).

35 U. S. C. §116 makes it obligatory for a patent to be applied for jointly where the invention claimed is made by one or more persons jointly. If a patent issues upon the application of a person who claims to be the sole inventor and it later appears that the subject matter of the patent was invented jointly by two or more persons, the patent is invalid. Larson v. Crowther, 26 F. 2d 780, 789 (8 Cir. 1928), cert. den. 278 U. S. 648, 49 S. Ct. 83, 73 L. Ed. 560 (1928); Worden v. Fisher, 11 F. 505, 506 (C. C. E. D. Mich. 1882); Fox v. Spiegel, 50 F. 2d 195 (D. Conn. 1931). It is this principle which defendant invokes to invalidate the patent in suit.

Defendant's contention that Burch was a joint inventor is rejected. It is true that, as Farber testified, the Burch thermostat was the heart of Foster's patent. Nevertheless, prior to October 12, 1954 the Burch thermostat had been freely demonstrated and Burch had sold 50 of the units for use on aircraft ground heaters. Burch's disclosure of the thermostat to Foster was not confidential or secret. It was clearly in the prior art when Burch revealed it to Foster.

Furthermore, when Burch visited Foster on October 12, 1954, he did not know why Foster was interested

in his thermostat. During the meeting Burch suggested no use for it, although at the meeting he learned that Foster's interest was in finding a thermostat to use in an electrical plug with a frying pan. The problem which Foster was seeking to solve was one which Foster—not Burch—had recognized. The solution was sought by Foster—not Burch. Insofar as the Burch thermostat contributed to the solution, it was Foster—not Burch—who recognized its utility, in combination with other elements, to solve the problem upon which he alone was working when the Burch thermostat came to his attention. Prior to the time when Foster determined that the Burch thermostat might be useful, there had been no collaboration between Burch and him, nor had they been working together toward a common end. These are essential to joint inventorship. Pointer v. Six Wheel Corp., 177 F. 2d 153, 157 (9 Cir. 1949); McKinnon Chain Co. v. American Chain Co., 268 F. 353, 360 (3 Cir. 1920).

Furthermore, the fact that Burch was the inventor of the thermostat did not make him a joint inventor of the combination in which the thermostat was but a part. A patent consisting of a combination of elements is, in legal contemplation, a separate and distinct entity from any of its component parts. A person who is the sole inventor of a combination, wholly apart from whether he is an inventor of an element thereof, is entitled to a patent on the combination. Great Atlantic & Pacific Tea Co. v. Supermarket Equip. Co., 340 U. S. 147, 150-153, 71 S. Ct. 127, 95 L. Ed. 162 (1950); Helms Products, Inc. v. Lake Shore Mfg. Co., 227 F. 2d 677, 681 (7 Cir. 1955); Coleman v. Holly Mfg. Co., 233 F. 2d 71, 79 (9 Cir. 1956), cert. den. 352 U. S. 952, 77 S. Ct. 326, 1 L. Ed. 2d 243 (1956). A combination patent may be valid even if every element of the combination is old provided that there is invention in the combination as an entirety. General Motors Corp. v.

Swan Carburetor Co., 88 F. 2d 876 (6 Cir. 1937), cert. den. 302 U. S. 691, 58 S. Ct. 49, 82 L. Ed. 534 (1937), reh. den. 302 U. S. 777, 58 S. Ct. 137, 82 L. Ed. 601 (1937).

One further aspect of the matter must be considered. It is admitted by plaintiff that at the time when Foster built the bread board model on October 13 he had not conceived of the invention disclosed by Claim 1[5] and that Foster's cooking experiment on October 14 was not a reduction to practice of the invention.[6] The bracket to which the probe, electrical contacts and adjusting screw are affixed in Claim 1 were missing from the bread board model and had not been conceived of when it was built.[7] The omission of the bracket from the bread board model is the only difference between it and Claim 1.

The bracket was essential to satisfactory operation of the thermostat and is a material element in Claim 1. Defendant argues that the utilization of the bracket was conceived of by either Moorhead or Butts sometime after Burch and Comee met with Foster and Farber on October 22, and that the model of the thermostat which they built and submitted to plaintiff on December 2 (when tested on or about that date) was the first reduction to practice of the invention disclosed in Claim 1. This conception and reduction to practice by Moorhead or Butts, defendant argues, made them joint inventors with Foster.[8]

On the other hand, plaintiff contends that sometime between October 12 and October 22 Foster conceived that

5. Transcript of Argument—October 25, 1962—p. 28.

6. Transcript of Argument—October 25, 1962—p. 23.

7. Whether the bread board model was operative for its intended purpose is immaterial. Admitted, it was not a desirable commercial arrangement.

8. Defendant's alternative contention that Farber was a joint inventor with Foster is outside of the issues defined by the pretrial order. See footnote 2.

a unitary assembly fixing the probe in a rigid relationship with the electrical contacts and adjusting screw was essential to a satisfactory operation of the thermostat and that Farber and Foster disclosed this to Comee and Moorhead when they visited plaintiff's plant on October 22. Plaintiff asserts further that the use of the bracket involved no inventive skill by defendant's employees since the use of the bracket was the usual and normal way to make a unitary thermostatic assembly, and that Foster and Farber had told Moorhead and Comee that such a unitary assembly was necessary. Because of this, plaintiff argues that although the model which defendant built was the first reduction to practice of the invention, it was in legal contemplation a reduction to practice by Foster, since defendant's employees were just "another pair of hands" working for Foster.

On these key issues the evidence is not too satisfactory. On balance, however, it supports a finding that Foster recognized, after his cooking experiment on October 14, 1954 and before he met with Comee and Moorhead on October 22, 1954, that it was necessary for the probe, electrical contacts and adjusting screw to be kept in rigid alignment by means of a unitary assembly in order to obtain accurate calibration, to permit the requisite amount of play of the thermostat in the plug, and to enable the thermal unit to be shipped satisfactorily for assembly in the plug by Leviton. This finding is based upon the testimony of Foster and Farber as to discussions which they had with each other between October 14 and October 22. It is not corroborated by any other witness or by documentary evidence of any kind. While such testimony is, as a rule, somewhat suspect, I find no reason to reject it in this case.

Despite Foster's conception, his invention was not complete until he had reduced it to practice. This is a settled principle of patent law. Hann v. Venetian Blind

Corp., 111 F. 2d 455, 458 (9 Cir. 1940); Consolidated Vultee Aircraft Corp. v. Maurice A. Garbell, Inc., 204 F. 2d 946, 949 (9 Cir. 1953), cert. den. 346 U. S. 873, 74 S. Ct. 122, 98 L. Ed. 381 (1953); Corona Cord Tire Co. v. Dovan Chem. Corp., 276 U. S. 358, 383, 48 S. Ct. 380, 72 L. Ed. 610 (1928). A machine is reduced to practice when it is assembled, adjusted and used. E. I. DuPont De Nemours & Co. v. American Cyanamid Co., 120 F. Supp. 697, 701 (D. D. C. 1954); Corona Cord Tire Co. v. Dovan Chem. Corp., supra. To establish reduction to practice of an invention for a mechanical device, the device tested must include all of the elements of the claim in issue. Akers v. Papst, 113 F. 2d 136, 139, 27 CCPA 1400 (1940); Greene v. Beidler, 58 F. 2d 207, 208 (2 Cir. 1932). Compare Daniels v. Permutit Co., 137 F. 2d 823 (3 Cir. 1943). The model constructed by defendant's employees and exhibited to Foster and Farber on December 2, 1954 constituted the first reduction to practice of the invention asserted in Claim 1. The question is therefore whether this was in legal contemplation a reduction to practice by defendant's employees in their own right, or as "another pair of hands" for Foster.

On October 22, Farber and Foster had their first meeting with representatives of the defendant following Foster's initial meeting with Burch on October 12. Four persons were present: Foster, Farber, Burch and Comee. The net of the testimony of Foster and Farber is that they told Burch and Comee that it would be necessary to construct the thermostat so that the contacts, probe and adjusting screw would be supported as a unit. On the other hand, Burch testified that there was little discussion at the time. When asked whether he received any advice as "how to produce a * * *", he interrupted the question and answered, "Absolutely none, this is a positive statement." However, he testified that he understood from Foster and Farber that plaintiff wanted defendant to manufacture a

"complete thermostat," and that a "complete thermostat" would have to "include the bracket and contacts".

At the meeting on November 11, while various business phases of the transaction were being discussed by Farber and Ottmar, Foster had technical discussions with Comee. Foster testified that he told Comee of the manufacturing requirements, and that he pointed out again that the thermostat and contacts would have to be a complete unit so there would be a rigid mounting of the contacts and the probe to eliminate unwanted motion.

At the time when Moorhead built the model which he exhibited to Foster and Farber on November 17, he had not talked to anyone in plaintiff's organization. When he was asked who designed and put the bracket into the model, he testified, "That was my idea". Moorhead said that the information which he used in making the thermostat was obtained from Comee and possibly from Burch, and that, "I remember most of my information came from our representatives that brought the information back from Farber." Moorhead made no claim to have improved upon the device which he had been instructed to build.

Defendant relies heavily upon Foster's deposition to establish that defendant's employees were the first to conceive of the use of the bracket to join the probe, contacts and adjusting screw. In his deposition Foster testified that the bracket and the affixation of the bracket to the contact members was a contribution of Burch and the Metals & Controls people. Foster said that his contribution went back to the original idea of a probe type thermostat in a frying pan and that the details were someone else's. Shortly before this testimony had been elicited, Foster had been asked whether he or Spencer or Burch had developed the "mechanical details" of the thermostat, to which Foster replied that he assumed that Burch had. The testimony which followed this inquiry, and upon which

defendant relies so heavily, could well have been understood by Foster as referring to the "mechanical details" about which he had just been interrogated. When Foster was examined by plaintiff at the trial on the subject of his deposition, he said he considered that the deposition questions had related to the actual physical parts of the thermostat. All things considered, this explanation seems reasonable enough.

There is no proof that either Foster or Farber told defendant's employees that in manufacturing the thermal element they should utilize a bracket to keep the contacts and probe in alignment. Defendant's representatives were told, however, that a unitary assembly of the probe and contacts was essential. The normal and usual way in which to construct the unitary assembly was by means of a bracket. Dr. Fischer, defendant's expert, admitted that it would take considerable thought on his part to make a unitary assembly in any other way. Under the circumstances, the specific design contribution by defendant's employees—the bracket to effect a unitary assembly—did not rise to the height of an inventive contribution. In the light of the instructions they received from Foster, the use of the bracket was a mechanical detail of an obvious kind which any qualified engineer or designer could reasonably be expected to make. This was not enough to establish a joint invention. Alto Company v. Fish Manufacturing Co., 158 F. Supp. 752, 755 (D. N. J. 1957), aff'd per curiam 252 F. 2d 299 (3 Cir. 1958); Adams v. Columbus Mfg. Co., 180 F. Supp. 921, 929 (M. D. Ga. 1960); 1 Walker, Patents (Dellers' Ed. 1937) 403.

It has been said that one may be a joint inventor, even though the conception of the entire device may be due to another, if he makes suggestions of a practical value which assist in making the main idea operative, or contributes an independent part of the entire invention which is united with the parts produced by the other and creates the whole.

Altoona Publix Theatres, Inc. v. American Tri-Ergon Corporation, 72 F. 2d 53, 56 (3 Cir. 1934), rev. on other grounds, 294 U. S. 477, 55 S. Ct. 455, 79 L. Ed. 1005 (1935). This principle is without application to the case at bar, since no suggestions of practical value were made by employees of defendant save those which were obvious under the instructions which Foster and Farber gave to them.

Cases such as Q-Tips, Inc. v. Johnson & Johnson, 207 F. 2d 509, 511 (3 Cir. 1953), cert. den. 347 U. S. 935, 74 S. Ct. 630, 98 L. Ed. 1086 (1954), which hold that in a suit for the infringement of the combination patent, every element claimed is deemed essential and the patentee will not be heard to assert its immateriality, are without relevance here. Plaintiff does not disavow the importance of the bracket to the satisfactory operation of the thermal unit. Its importance is conceded. Plaintiff simply asserts Foster and Farbar explained to defendant's employees the necessity for a unitary assembly of the probe and contacts and that the use of a bracket was the normal and obvious way to make it.

Working as they did under instructions which they had received from Foster and Farber in an effort to produce a thermostat which would be satisfactory to plaintiff, defendant's employees were simply "another pair of hands" for Foster. It is not material that plaintiff made no payment to defendant for its development work and that the price of the thermostat did not include as a factor the development costs of defendant.

It follows that neither Burch nor defendant's employees, Moorhead or Butts, was a joint inventor with Foster of the subject matter of Claim 1.

This opinion constitutes the findings of fact and conclusions of law required by F. R. Civ. P. 52(a).

December 5, 1962
Wilmington, Delaware

Appendix B

Decision—Second Trial

IN THE

UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

Civil Action No. 2271

STEEL, J:

S. W. Farber, Inc., the plaintiff, sued Texas Instruments Incorporated, the defendant, for infringement of United States Letters Patent No. 2,926,230 issued to plaintiff as assignee of Hoyt K. Foster, the patent applicant. The patent states that it pertains to an improved detachable electrical connector and temperature regulator for electrically controlled heating devices. Defendant has denied validity but admitted infringement if the patent is valid. The thermostatic control plugs which defendant has manufactured and sold to West Bend Company, Mirro Aluminum Company and McGraw Electric Company are illustrative of the accused devices.

Defendant has filed two counterclaims. The first seeks a declaratory judgment adjudging the patent to be invalid, or alternatively, that the invention claimed was made in whole or in part by persons associated with defendant or its predecessor. The latter issue was tried separately and determined adversely to defendant. *S. W. Farber, Inc.* v. *Texas Instruments Incorporated,* 211 F. Supp. 686 (D. Del. 1962).[1] The second counterclaim is for unfair competition.

Much of the background of the controversy is disclosed in the opinion at 211 F. Supp. 686 and the Findings of

1. Defendant has reserved the right to appeal from this decision.

Fact and Conclusions of Law stated there are incorporated herein by reference. By stipulation the record in the earlier trial is part of the present record.

JURISDICTION

The complaint seeks relief under the patent laws and jurisdiction exists under 28 *U. S. C.* §1338(a). Counterclaim 1 arises out of an actual controversy between the parties as to the charge of infringement made by plaintiff against defendant and defendant's contention that it has rights to the patent in suit which plaintiff denies. Jurisdiction of counterclaim 1 exists under 28 *U. S. C.* §§2201-2202. Counterclaim 2 alleges a claim for unfair competition which has been joined with a substantial and related claim under the patent laws. Jurisdiction over counterclaim 2 exists under 28 *U. S. C.* §1338(b).

THE VALIDITY ISSUE

The parties have agreed that claims 2 and 4 are typical or representative, that if claims 2 and 4 are valid, all claims are valid; if claims 2 and 4 are invalid, all claims are invalid, and if either claim 2 or 4 is valid and the other invalid, the remaining claims are not adjudicated.

While a number of defenses have been pleaded, only that asserted under 35 *U. S. C.* §103 need be dealt with.[2] It provides that although an alleged invention is not identically disclosed or described in the prior art specified in Section 102 of Title 35, a patent may not be obtained if

2. Defendant sought leave to plead the defenses of unclean hands, patent misuse and anti-trust violation. Leave was denied because their assertion was not timely.

the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time of the invention to a person having ordinary skill in the art.

In early 1954 two thermostatically controlled fry pans were put on the market. One was manufactured by Sunbeam and the other by Presto. The Presto pan could not be immersed in water for washing. That manufactured by Sunbeam could be immersed only up to the temperature dial on the handle and carried a notice to that effect. It had the thermostat permanently secured in the handle, and it could not be detached.

Sometime in 1954 Foster, the chief engineer of the plaintiff, recognized the desirability of developing an electrically heated, thermostatically-controlled fry pan which could be completely immersed for washing without damaging the pan. This was not possible with any of the electrified fry pans then being marketed.

With complete immersibility as his goal, Foster, prior to October 12, 1954, conceived the general idea of putting a probe type of thermostat in an electric plug which could be detached from the pan when it was washed. Under this general concept a portion of the probe would extend from the plug through a hole midway between the receptacle contacts of the plug and enter a recess in the bottom of the pan so as to engage the bottom of the pan and sense its temperature when the plug and pan were in operational relationship. It was Foster's idea that when the electric current heated the pan above the desired temperature the thermostat would open the circuit, and when the temperature of the pan fell below the desired temperature the thermostat would close the circuit, thus enabling the heat of the pan to be maintained at a relatively uniform predetermined temperature.

Appendix B — Decision—Second Trial

On November 30, 1954 Foster filed a patent application, Serial No. 471,949, embodying this concept. It eventuated in patent No. 3,095,498. The 498 patent is not in suit, for it did not issue until June 25, 1963 after the present action was begun. The 498 patent is for a combination consisting of an electrical cooking utensil and a detachable thermostat housed in an electrical plug. This initial concept did not embrace the use of any particular kind of probe thermostat, although there were several types on the market. The specifications provided that the thermostat could be

> "operated in any conventional manner such as by means of a bi-metal element or an expansible fluid and bellows and is preferably of the "on-off" type with the adjustment of the device being effected by means of a knob * * *".

As stated, the 230 patent relates to an "improved" detachable electrical connector and temperature regulator for electrically controlled heating devices, such as a cooking utensil. Unlike the 498 patent, the 230 patent does not claim the device with which the connector is to be used. The 230 patent is merely for a specific type of probe thermostat consisting of a combination of elements housed in an electrical plug. It is intended for use as a substitute for the unspecified type of probe thermostat disclosed in the 498 patent.

The subject matter disclosed and claimed in the 230 patent was conceived by Foster sometime after his cooking experiment on October 14, 1954 and before October 22, 1954. It was reduced to practice on December 2, 1954. On that date the invention of the 230 patent was complete. *S. W. Farber, Inc.* v. *Texas Instruments Incorporated, supra,* p. 692. Foster filed his original application, Serial No. 535,797, on September 22, 1955, and this eventuated in the 230 patent on February 23, 1960.

Originally, Foster had in mind using a probe thermostat of the bulb and bellows type in his control plug.[3] Later, he began looking for a probe thermostat of the cartridge type. There were several of these on the market.[4] The first time that Foster saw one which was sufficiently small to be adapted to a removable plug for use with a fry pan was on October 12, 1954 when Lyndon W. Burch visited plaintiff's plant and showed Foster a cartridge thermostat embodying a "rod and tube" thermal element which Burch had developed.

The 230 patent carried forward Foster's original idea disclosed in the 498 patent, by substituting a unitary thermostatic switch embodying the thermal element which Burch showed Foster on October 12, 1954 in place of the schematic generalized showing of a thermostat found in the 498 patent.

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3. A bulb and bellows thermostat consists of a bulb, a pair of bellows, and a thin tube which connects the bulb and bellows. The bulb and bellows are usually metallic. What the tube is made of is not disclosed. The bulb, tube and bellows are airtight and contain a gas of some type. The bulb is immersed in or placed in contact with the material the temperature of which is to be controlled. When the material is heated the gas expands, and when the material cools the gas contracts. This expansion and contraction causes an increase or decrease in pressure which is transmitted through the tube to the bellows which are thereby caused to open and close. The end of the bellows outside of the tube are attached to an electrical contact. When the bellows open, the circuit is broken; when the bellows close, the circuit is closed. In this way the heat which is electrically generated can be maintained at a pre-determined temperature.

4. One type of cartridge thermostat is composed of a piece of hollow tubing closed at one end. Enclosed within the tubing is a bi-metallic thermal element consisting of two flat strips of different metals bonded to each other, which expand at different rates upon being subjected to heat. One end of the bi-metallic element is mounted within the tube. The other end extends out of the open end of the tube and is connected to an electrical contact. Upon the application of heat to the tube one strip in the thermal element expands at

The thermal element disclosed by the 230 patent was the subject of an application, Serial No. 420,064 which Burch had filed on March 31, 1954. This eventuated in patent No. 2,793,270 which issued to Burch on May 21, 1957.

The critical question under 35 *U. S. C.* §103 is not whether the alleged invention in the 230 patent is identically disclosed or described in the prior art specified in 35 *U. S. C.* §102. The issue is whether the differences between the subject matter of the 230 patent and the §102 prior art are such that the subject matter of the 230 patent as a whole would have been obvious on December 22, 1954 to anyone having ordinary skill in the art to which its subject matter pertains.

When Foster faced the problem of developing a detachable temperature regulating connector to be used with

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greater rate than the other. This effect causes a mechanical bending of the bi-metal element, thereby creating lateral movement at the end of the element affixed to the electrical contact. This movement opens the contact. Conversely, when the heat is removed the metals contract at different rates causing an unbending, lateral movement in the opposite direction of the bi-metal element and a closing of the contact.

Another kind of cartridge thermostat is the "rod and tube" type. This consists of a hollow tube closed at one end. The tube is made of a high expansion metal. A rod inside the tube is of low expansion metal and one end thereof is fastened in the tube to the closed end of the tube. The other end of the rod is fastened to a flexible narrow extension of the wall of the tube at its open end. When heat is applied to the cartridge the tube expands longitudinally at a greater rate than the rod, thereby casting the flexible extension on the tube to be pulled toward the center of the tube. The extension is fastened to an electrical contact which is caused to be opened by the movement of the extension. When the heat is removed the tube contracts at a greater rate than the rod and the extension is pushed in the opposite direction, closing the contact. Thermostats employing the bi-metal principal were used for breaking electrical circuits long before 1941 for a wide variety of electrical devices such as flat irons, coffee cookers, bread toasters, etc. *Cuno Engineering Corp.* v. *Automatic Corp.*, 314 U. S. 84, 88 (1941).

electrically heated devices, he was chargeable with knowledge of the following prior art patents: Gaunt British patent No. 599,224 for which complete specification was accepted on March 8, 1948, Ross United States patent No. 1,431,542, which issued on October 10, 1922, Norton U. S. patent No. 2,024,471 which issued on December 17 1935.[5]

Each of these three patents disclosed, as does the 230 patent, a detachable temperature controlling connector unit for an electrically heated device having spaced terminals, the connector unit comprising in combination a housing and a pair of spaced terminals for cooperating with the terminals of the device to be heated for applying electrical energy thereto. Each of the three patents contains a thermostat of some type.

Claim 2 of the 230 patent reads:

> "*A detachable temperature controlling connector unit for an electrically heated device, having space*[*d*] *terminals, said connector unit comprising in combination a housing, a pair of space*[*d*] *terminals for cooperating with the said first terminals for applying electrical energy thereto,* a support mounted within said housing and carrying a tubular member extending outwardly from said housing in relation to the terminals thereof, said tubular member being adapted to be positioned in heat transfer relation with the said device when its said terminals are positioned in cooperation with the first terminals on said device, a pair of resilient contact carrying members on said support and connected to control the application of energy to said terminals, adjustable means for fixing the position of one of said contact carrying members, and means within said

5. The question of whether British patent No. 725,341 or Belgian patent No. 518,320 were in the prior art on December 12, 1954 need not be decided.

tubular member having its inner end in engagement with the distal end of the tubular member, the outer end of the last said means coupled in motion amplifying relationship to the other of said contact carrying members to actuate the contact carrying members in response to temperature changes sensed by said tubular member, the temperature at which said actuation of the contact carrying members takes place being determined by the position of one contact carrying member."[6]

Kelley, who testified as an expert for plaintiff, identified the underscored [italicized] portions of claim 2 as described in the Ross Patent No. 1,431,542.

Claim 4 of the 230 patent reads:

"*A detachable temperature regulating and power-supplying connector for an electrically heated device, comprising in combination an elongated hollow housing, having an end-wall part, including at least three spaced openings, a pair of terminals in said housing aligned with two of said openings,* a metallic bracket within said housing, an elongated hollow metallic probe fixedly secured to said bracket and extending through the third of said openings and from the housing, a pair of cooperating contacts within said housing, and affixed in insulating relationship to said bracket, an elongated member within said probe with one end of said member engaging the distal end of said probe, and the other end of said member in coupled, motion amplified relationship with said contacts to open and close them in accordance with changes in temperature of said probe, a power supply cable attached to said hous-

6. Underscoring supplied unless otherwise indicated. [The words underscored by the Court are indicated in this Record by italics.]

ing and connected to one of said housing terminals and one of said contacts and a connection between the other of said contacts and the other of said housing terminals."

Kelley stated that the underscored portion of claim 4 described the disclosure of the Ross Patent No. 1,431,542.

The underscored portions of claims 2 and 4 make no reference to a thermostat. The language of the claims which is not underscored describes the thermostatic element of the claims. Obviously, it is not the thermostat which Ross disclosed.[7] The language which is not underscored does, however, describe the "rod and tube" thermal actuator of the then pending Burch patent application, plus a bracket (mounted in the plug) which connects the thermal actuator with a pair of resilient contact carrying members and a screw to adjust the position of one of the members.

Prior to December 2, 1954, when Foster completed his invention, the Burch thermal actuator disclosed in Burch's application filed on March 31, 1954, was part of the prior art, since Burch's application antedated Foster's, and Burch's patent was issued prior to Foster's 230 patent. *Detrola Corp.* v. *Hazeltine Corp.*, 313 U. S. 259, 265, 269 (1940).[8] In addition, Burch had actually exhibited his thermal actuator to Foster on October 12, 1954. This was not done in a confidence, nor with the exaction of pledges of secrecy from Foster.

7. The Ross patent disclosed a metallic thermostat composed of two thin strips of metal having different coefficients of expansion connected to a metallic conducting pin designed to project outwardly through the middle hole of the connector and to abut against, or enter a suitable recess in the utensil, the heat of which was to be controlled.

8. Although this decision antedated the 1952 Patent Act, the same rule has been applied under the 1952 Act. *Hazeltine Research, Inc.* v. *Ladd*, 226 F. Supp. 459 (D. C. D. C. 1964).

There was nothing inventive about using the Burch thermal actuator to thermostatically control the opening and closing of an electric circuit. Prior to October 12, 1954, Burch had shown a thermostat using his thermal actuator to a manufacturer's representative in Connecticut, and a thermostat employing the Burch actuator had been used commercially on an aircraft ground heater. Indeed, when Burch met with Foster on October 12, he showed him a thermostat (DX 29) which employed his thermal actuator, although it was not in an electrical plug.[8-a] So that a thermostat which embodied the Burch actuator was also in the prior art before October 12, 1954.

To give the Burch thermal element the utility which Foster disclosed in the 230 patent, it was necessary to do two things: first, connect the probe, switch contacts, and a screw for adjusting the contacts by a metallic bracket so as to hold the three elements together rigidly as a unit, and second, install the assembly (probe, contacts, and adjusting screw so connected) in an electric plug having two electrical receptacles with a hole between through which the probe extended to perform its heat sensing function when in contact with the bottom of the fry pan.

The physical accomplishment of these two steps was carried out by employees and associates of the defendant working as "another pair of hands" for Foster and under his direction. See *S. W. Farber, Inc.* v. *Texas Instruments, Incorporated, supra,* 693. The use of a bracket to render the assembly unitary so that the probe, contacts and adjusting screw were joined together in a fixed and rigid relationship with each other, was not inventive. It was simply the mechanical way to accomplish the desired result and would have been readily perceptible to any worker skilled in the field who was told to combine the three ele-

8-a. Whether Burch also showed Foster DX 44 and 46 need not be determined.

ments into a single rigid assembly. *S. W. Farber, Inc.* v. *Texas Instruments Incorporated, supra,* p. 693. Nor did the general idea that the assembly would have to be unitary, which Foster imparted to the employees and associates of defendant, rise to the height of invention. If the thermostat were to have accurate calibration, the amount of wiggle or play in the plug required because of the expansion and contraction of the fry pan when in contact with the probe, and be in condition to be shipped to the Leviton Manufacturing Company (as was planned) for installation in the plug, it was necessary for the probe, contacts, and adjusting screw to be held together rigidly as a unit. This would have been obvious to anyone having ordinary skill in the art. The concept of installing the thermostat in the plug was not inventive, for that idea was revealed not only in Ross but also in the Gaunt British Patent No. 599,224 and Norton U. S. Patent No. 2,024,471.

Kelley pointed to many deficiencies in the Ross patent which he said made the operation of its structure impractical. The "most glaring ones" he said, were the shock hazards and possibility of short circuits. Kelley acknowledged, however, that these deficiencies would be recognized by a person skilled in the art and could be readily corrected. Kelley also pointed out that the erratic ambient temperature variations inherent in the Ross structure would cause it to operate unsatisfactorily. But this defect, and others which Kelley emphasized to a lesser degree, could all be remedied by substituting the Burch thermal probe in unitary assembly with the contact switches and adjusting screw, for the metallic conducting pin and thermostatic arrangement disclosed by Ross.

Defendant* argues that it is not permissible for an infringer to go to the prior art and defeat a patent by select-

* Should be Plaintiff.

ing various elements thereof and bringing them together and saying that the aggregation anticipates invention of the patent. *Atlantic Refining Co.* v. *James B. Berry Sons Co.*, 106 F. 2d 644, 650 (3rd Cir. 1938) so holds. But here the defense under examination is not anticipation dealt with by §102; the defense is obviousness under §103.

Plaintiff concedes that all of the structural elements found in claims 2 and 4 of the 230 patent were known before Foster conceived of his alleged invention. The conjunction or concert of known elements must contribute something. Only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. This is established doctrine. *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp.*, 340 U. S. 147, 152 (1950). There, a patent consisting of a combination of mechanical elements was held to be invalid because the combination had not resulted "in any unusual or surprising consequences," 340 U. S. at 152. The same thing is true of the combination of elements disclosed in claims 2 and 4 of the 230 patent. The Burch thermal element works in precisely the same manner regardless of whether it is in or out of the structure of the 230 patent. It would also work in the same way if it were in the Ross patent.

It may be conceded that the function performed by the structure disclosed in the 230 patent was "new and useful". This, however, is not enough to make it patentable. Under 35 *U. S. C.* §101 "invention" or "discovery" is a prerequisite to patentability. See *Cuno Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 90 (1941) decided under 35 *U. S. C.* §31; *R. S.* §4886, the forerunner of §101 of 35 *U. S. C.* In *Chemical Construction Corp.* v. *Jones & Laughlin Steel Corporation*, 311 F. 2d 367, 371 (3rd Cir. 1962), the Court stated that the *Great Atlantic & Pacific Tea Co.*, *Cuno Engineering Corporation*, and other Supreme Court cases had established a "high standard" of inventiveness

which was required to warrant the issuance of a patent. Claims 2 and 4 fail to meet that standard.

Plaintiff points out that both the Ross and Burch patents were cited in the Patent Office against the 230 patent but nevertheless the subject matter of 230 was held to be patentable. Admittedly, this enhances the presumption of validity which arose when the patent issued. *Hartford National Bank & Trust Co.* v. *E. F. Drew & Co., Inc.*, 133 F. Supp. 648, 652 (D. Del. 1955), aff'd. 237 F. 2d 594 (3rd Cir. 1956). But this circumstance is not of controlling significance. The standard of inventiveness employed by the patent office is far below that applied by the courts. *Picard* v. *United Aircraft Corporation*, 128 F. 2d 632, 641 (2nd Cir. 1942), cert. den., 317 U. S. 651 (1942). The category of patented unpatentables has been held to be large. *Packwood* v. *Briggs & Stratton Corp.*, 195 F. 2d 971, 974 (3rd Cir. 1952), cert. den. 344 U. S. 844 (1952).

Plaintiff likewise stresses the fact that the structure disclosed and claimed by Foster has come into widespread use, been adapted by industry, and achieved commercial success. Commercial success, however, without invention will not make patentability. *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp., supra*, p. 153.

In view of the Ross patent and the Burch thermal switch, the difference between claims 2 and 4 of Foster's 230 patent and the prior art on December 2, 1954 were such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which the subject matter of the patent 230 pertains. Invention is lacking. Patent 230 is, therefore, invalid, and the complaint will be dismissed. A declaratory judgment will be entered under Counterclaim 1 adjudging the 230 patent to be invalid.

UNFAIR COMPETITION

Defendant's counterclaim for unfair competition is based upon the contention that plaintiff (i) advertised its plug as patented almost five years before the 230 patent issued, (ii) obtained a patent for a device which was not patentable, and (iii) threatened customers of defendant with infringement suits so as to make it necessary for the defendant to indemnify them.

Preliminarily, a word should be said about the law to be applied. The unfair competition claims have their source in state law and would appear to require the application of state law even though they arise in litigation involving a claim of patent infringement based upon federal law. *C.f., Maternally Yours* v. *Your Maternity Shop,* 234 F. 2d 538, 540-541, N. 1 (2nd Cir. 1956); *Blisscraft* v. *United Plastics Company,* 294 F. 2d 694, 697 (2nd Cir. 1961). Although there is evidence where some of the alleged acts of unfair competition took place, such as the states in which defendant's customers were threatened with infringement suits by plaintiff, neither of the parties has raised any question about whether federal or state law should be applied or has asserted that the application of the law of one state as against that of another brings about a different result. Under the circumstances, reliance upon the "indeterminate general law" is warranted. *Maternally Yours* v. *Your Maternity Shop, supra,* p. 540, N. 1; *American Safety Table Co.* v. *Schreiber,* 269 F. 2d 255, 271 (2nd Cir.), cert. den. 361 U. S. 915 (1959).

It is conceded that plaintiff distributed a circular to dealers in October of 1955 which depicted its "automatic electric fry pan" and said:

Appendix B — Decision—Second Trial

"EXCLUSIVE! *Thermostatic Control*
IN THE PLUG!

> This new amazing, patented Farberware feature means you can *completely* immerse the fry pan in water for safer, easier, quicker cleaning.'"[9]

About 40,000 of these circulars were printed, although the precise number which plaintiff distributed is not disclosed.

The claim that the Foster plug was patented was, of course, untrue inasmuch as the 230 patent did not issue until February 23, 1960. An announcement that a device is protected by a patent when in fact it is not does not amount to unfair competition unless the announcement was intentional. *Deering, Milliken & Co.* v. *Temp-Resisto Corporation,* 160 F. Supp. 463, 485 fn. 11 (S. D. N. Y. 1958); mod. on other grounds, 274 F. 2d 626 (2nd Cir. 1960).

Circulars distributed in late 1955 or early 1956 made no claim that the plugs were patented. None of the booklets which accompanied the appliances distributed from 1955 on indicated that the plugs were protected by patents. The control plugs which plaintiff sold in 1955 and 1956 were marked, quite properly, "patent pending." An advertisement by plaintiff in *Life* in the spring of 1956 as well as a reproduction thereof which plaintiff supplied to its dealers for display with its merchandise, likewise stated that a patent was pending on the control plug. Plaintiff was not aware of its erroneous claim that its plug was patented until defendant called it to plaintiff's attention when Foster's deposition was taken on December 2, 1960. From this combination of circumstances, it is clear that the claim

9. Emphasis appears in the circular.

that the plug was patented, which plaintiff made in a single batch of circulars distributed in October 1955, was inadvertent and not occasioned by any deliberate intention to gain an unfair advantage over defendant or other competitors.

Within a month after the 230 patent issued, plaintiff wrote certain of its competitors and charged that devices which they were selling infringed plaintiff's patent rights. This was not an unfair competitive practice. The patent, having issued, was presumptively valid. 35 *U. S. C.* §282. The very purpose of the patent was to enable plaintiff to prevent non-permissive use of structures covered by it. The notices which plaintiff sent were in furtherance of this purpose.

It is not significant that plaintiff threatened to sue customers of the defendant for infringement and that this compelled defendant to indemnify its customers against damages they might sustain as a result of such actions. At the time, the patent was presumptively valid. There is no evidence that plaintiff's infringement notices were sent in bad faith for the sole purpose of destroying the defendant's business. In the absence of such proof the giving of the infringement notices was not wrongful. *A. B. Farquhar Co.* v. *National Harrow Co.*, 102 Fed. 714, 715 (3rd Cir. 1900); *Cheney Co.* v. *Cunningham*, 37 F. Supp. 224, 230 (W. D. Pa. 1941); aff'd 127 F. 2d 294 (3rd Cir. 1942).

Counterclaim 2 based upon plaintiff's alleged unfair competition will be dismissed.

The case is not such an exceptional one as to justify an award of attorneys fees to the defendant under 35 *U. S. C.* §285.

Wilmington, Delaware
May 8, 1964

Appendix C

Judgment Appealed to the Third Circuit Court of Appeals

IN THE

UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

This action came on for trial before the Court, Honorable Edwin D. Steel, District Judge, presiding, and the issues having been duly tried and a decision having been duly rendered.

IT IS ORDERED AND ADJUDGED:

That the Plaintiff take nothing, and that the action be dismissed on the merits.

That Counterclaim 1, based upon the alleged invalidity of the Foster patent, be granted to the extent that United States Letters Patent No. 2,926,230 issued to Plaintiff as assignee of Hoyt K. Foster be adjudged invalid and void and of no force and effect.

That Counterclaim 2 based upon Plaintiff's alleged unfair competition be dismissed on the merits, and that Defendant, Texas Instruments Incorporated, take nothing thereon.

That the costs incident to the main action and to the counterclaim seeking declaratory relief adjudging Letters Patent No. 2,926,230 to be invalid, be taxed against Plaintiff; the costs incident to the counterclaim seeking relief based upon Plaintiff's alleged acts of unfair competition be taxed against defendant; and that the amount of the cost to be taxed against each party be determined by the Clerk upon the application of either party.

Appendix C

Judgment Appealed to the Third Circuit of Appeals

That the opinion herein constitutes the findings of fact and conclusions of law herein.

Dated at Wilmington, Delaware, this 12th day of June, 1964.

/s/ Edwin D. Steel, Jr.
D. J.

Appendix D

Opinion of the Court

(Filed April 20, 1965)

UNITED STATES COURT OF APPEALS

FOR THE THIRD CIRCUIT

PER CURIAM:

This patent infringement suit, tried to a district judge sitting without a jury, resulted in a judgment on the merits for the defendant. The court found that the claimed invention consisted of mechanical improvements and adaptations of the prior art which would have been obvious at the time in question to a person of ordinary skill in the art. Accordingly, applying the test stated in section 103 of Title 35, U. S. C., the court held that the differences between the subject matter sought to be patented and the prior art were not patentable.

The finding of obviousness is supported by affirmative testimony and cannot be characterized as unreasonable or unwarranted in the light of a record which discloses fully and with particularity the simple mechanical adaptations of familiar structures, directly indicated by the problem to be solved, which are the essence of the claimed invention.

The judgment will be affirmed on the proper findings and the logical and convincing analysis of the district court. 1964, 230 F. Supp. 883.

A True Copy:

Teste:

Clerk of the United States Court of Appeals for the Third Circuit.

Appendix E

UNITED STATES COURT OF APPEALS

FOR THE THIRD CIRCUIT

ON APPEAL FROM

THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

Present:

HASTIE and FREEDMAN, *Circuit Judges,*
and WEBER, *District Judge.*

JUDGMENT

This cause came on to be heard on the record from the United States District Court for the District of Delaware and was argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of the said District Court filed June 12, 1964, in this case be, and the same is hereby affirmed, with costs.

Attest:

IDA O. CRESKOFF
Clerk

April 20, 1965

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MAR 13 1965
JOHN F. DAVIS, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 354

S. W. FARBER, INC., *Petitioner,*

v.

TEXAS INSTRUMENTS INCORPORATED, *Respondent.*

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

IN THE

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OCTOBER TERM, 1965

No. 354

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RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

STATEMENT

The statement of Petitioner is insufficient to give this Court a true picture of the background and circumstances as to the patent in suit and the question presented. Thus, Respondent must amplify Petitioner's statement to some extent.

Petitioner is the owner of two patents relating to electrically heated apparatus with detachable probe type thermostats. One of these is Patent No. 3,095,498 (hereinafter referred to as '498 patent) and the other

is Patent No. 2,926,230 (Defendant's Exhibit 1, Appellant's Appendix following page 158a, hereinafter referred to as '230 patent). The '498 patent embodies what the alleged inventor himself considered his invention to be, namely, that of an electrically heated apparatus such as a frypan in combination with a detachable probe type thermostat. The application for the '498 patent was filed in the U. S. Patent Office on November 30, 1954, but described and claimed no specific form of probe type thermostat for the detachable control plug. However, the specific rod and tube type thermostat of the '230 patent in suit was known to Petitioner at the time the application for the '498 patent was filed. Subsequently, on September 22, 1955, Petitioner filed a patent application directed intentionally to the rod and tube type thermostat now in suit (provided by Respondent or its licensor) and the application eventually became the '230 patent in suit. Petitioner has steadfastly avoided bringing the '498 patent into the suit although the subject matter thereof has been ever present.

The statement has been made in the paragraph above that the alleged inventor and patentee, himself, considered his invention to be that of the combination of an electrically heated apparatus and a detachable probe type thermostat, the '498 patent subject matter, and not the specific rod and tube type thermostat subsequently embodied in the '230 patent in suit. The basis therefor is that Lyndon W. Burch brought to the alleged inventor, Hoyt K. Foster, on October 12, 1954, several complete and working rod and tube type thermostats, demonstrated their operation to him and explained their construction in detail. The alleged inventor thereafter copied one of the thermostat

models into an appropriate electrical connector from one day to the next, tested his model and found it suitable for his purposes. The embodiment thus fashioned by the alleged inventor merely duplicated the work of Lyndon W. Burch in detachable thermostat control plugs well known in the art such as shown by Ross patent 1,431,542, Norton patent 2,024,471 and Gaunt British patent 599,224 (Petitioner's Appendix 40).

For support and verification of the above, portions of the deposition of the alleged inventor himself are quoted below (Appellee's Appendix, pp. 1b et seq.):

> Q. If we can, let's place the events that led up to your use of the rod and tube thermostat, and I think the easiest way is for you to tell me exactly how it happened that you came to the rod and tube thermostat. A. Starting some time in the early summer, or maybe a little before the early summer, of '54, I started asking every representative of a thermostat company that called on us if they made or if they knew anybody that made a cartridge type thermostat. In other words—
>
> Q. Maybe it would be a good idea to define cartridge type. A. I was referring to a cartridge type thermostat which would be used as a probe, not necessarily rod and tube. Then, when making this inquiry of a friend in Massachusetts, he told me that he had seen recently a cartridge type thermostat that he thought might be what I was looking for. It was shown to him by a distributor that I can't tell you the name of any more, in Hamden, Connecticut.
>
> * * * * *
>
> He showed me—rather, he told me—that the man who had this thermostat was Lynn Burch, and a few days after that, Lynn called me before I had a chance to get in touch with him. He then came

up to our plant on the 12th of October, as you'll find in the notes.

Q. 1954? A. 1954, yes. He showed us a working model of his thermostat.

Q. Can you identify either of those models we've presented to you? A. Yes, the one with the black box on it.

Q. The one with the little black box on it was the one that— A. I'm sure I saw that, and he had some other models with him which I couldn't be sure of at the moment.

Q. Can you determine whether or not the other device there was the other one that Lynn Burch showed you at that time? A. I wouldn't be sure that it was this one, but I'm sure it was different than the one with the black box. He had two or three different pieces with him.

Q. What happened subsequent to the time that Lynn Burch showed you those—what took place at that time? A. At that time he gave us a demonstration of how sensitive this thermostat was. He had a battery and a flashlight bulb with him, and adjusted the adjusting screw so that the thermostat was just on, and, take hold of the tube in your hand and almost like that the light would go out (witness snaps fingers).

Q. That's the one that Lynn Burch showed you on October 12, 1954? A. Yes.

Q. Were you at that time familiar with rod and tube thermostats? A. Oh, yes.

Q. To what extent? What did you know about it then? A. Well, the operating principles. Most of them, however, in order to give satisfactory sensitivity, had to be quite long, whereas this one made by Lynn Burch had a hinge arrangement with a multiplier for multiplying the motion which is produced by the differential expansion of the rod and tube.

Q. Was this the first rod and tube thermostat you had seen with such a motion multiplier in it? A. I don't believe so. I think I have seen motion

multipliers, but once again they were always large by comparison with what is in Burch's thermostat.

Q. Did this thermostat immediately appeal to you as being useful in your fry pan or cooking pan construction? A. Yes, I thought so.

Q. What did you next do? A. Made one like it.

* * * * *

Q. When did you make up this model to test it? A. The next day after Lynn visited us.

Q. That would have been— A. October 13, and I tested it on the 14th.

Q. What was the results of your test? A. Well, the tests were satisfactory enough so that we decided that's what we wanted to use if it were available.

* * * * *

Q. Did you yourself or those working for you or with you at Farber attempt to develop the mechanical details for the thermostat for the plug, or was that developed by Spencer, Burch and— A. We assumed that that was done by Burch. I mean he has it practically right here.

Mr. Mims: You were referring to this thermostat with the black box on it? The Witness: Yes.

Q. The particular construction of the thermostat that is shown in the drawings of the patent in suit, with which you're familiar, the particular construction is the construction developed by Burch or Metals & Controls. Is that right? A. Yes.

Q. So that your contribution to this, if any, was the idea of a detachable plug that would have a temperature-sensing unit in it and would have a probe that would stick in the cavity under the skillet. Is that right? A. That's right.

Q. Then you went to them to get a thermostat that would do the job? A. That's right.

Q. The details that we find in there, such as a bracket within the housing, which are included in some of the claims of the patent application, that

bracket was put in the device which you started making a broadboard model of—that bracket was put in by the people at M&C. Is that right? A. That's right.

Q. The fact that the electrical contact members were affixed to that bracket as they are in the patent drawings, this was a contribution from the Burch and M&C people. Is that right? A. That's right.

Q. The idea of the stacked relationship of the contacts that appears in the present device and in the drawings of the patent, that feature was contributed from Burch and the M&C group. Is that right? A. Yes.

Q. In other words, you didn't attempt to contribute that sort of thing? A. No.

Q. The motion multiplier feature, the mechanical motion multiplier feature of the thermostat, again was contributed by Burch. Is that right? A. Oh, yes, that's part of this thermostat here.

Q. In other words, he showed you that; you didn't show him that? A. No.

* * * * *

Q. Have we reached the conclusion in the discussion of your first patent application and the patent application that eventually resulted in the patent in suit that you had, at some time prior to the time you met Lynn Burch, had gotten the idea for a probe type thermostat under a fry pan—A. Definitely.

Q. (continuing)—and that when you met Lynn Burch was the time that you got the information about a rod and tube type thermostat, and the development of that came from M&C and this you then incorporated into your original idea? A. That's right.

Q. So that your contribution goes back to the original idea of a probe type thermostat under a fry pan, or under a cooking pan? A. That's right.

Q. The details are somebody else's? A. Yes.

* * * * *

As a further matter, the findings listed on pages 6 and 7 of the petition and attributed to the District Court are, first, an incomplete list of the findings made and, second, are worded to reflect the desires of Petitioner as to originality, novelty, success, etc., rather than being given the meaning and context intended by the District Court. Thus, to discern the actual findings of the District Court, it will be necessary to refer to the District Court's opinion on the cited pages following each of Petitioner's purported "finding of fact".

REASONS FOR DENIAL OF PETITION

As will be apparent from the two decisions of the District Court, the Court had before it a considerable number of reference patents and prior rod and tube thermostat constructions. Further, the testimony of the inventor, experts both for the Plaintiff and the Defendant and a number of fact witnesses was before the Court. From this, the Court reached the factual conclusion that "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains."

The Third Circuit Court of Appeals affirmed this decision per curiam in a three paragraph decision.

Petitioner is simply asking this Court to re-try a very thoroughly tried case and change the findings of fact of the District Court under the guise of setting a different "standard of patentability to be applied under Section 103."

In *Graver Tank Co.* v. *Linde Air Products Co.*, 339 U.S. 605, 611-612 (1949), this Court made its position

clear that it will not essay an independent review of the evidence.

The trial court made a number of findings of fact including the ultimate fact of obviousness. The Petitioner here has made no effort in either the Court of Appeals or this Court to show that the findings of the trial court were "clearly erroneous." F.R.C.P. 52(a).

The Petitioner has cited four cases (October 1965 Term) in which petitions for writ of certiorari were granted by this Court and has attempted to align itself with the obviousness and standard of patentability questions present in such cases. A close examination of these cases reveals that there were factors present which are not found in this Petitioner's Petition. In Number 11, *William T. Graham et al.* v. *John Deere Company of Kansas City et al.*, there is an actual conflict in decisions as to the same patent between the Fifth Circuit Court of Appeals and the Eighth Circuit Court of Appeals. Furthermore, the Eighth Circuit Court of Appeals' decision represents a reversal of the District Court decision holding the patent in suit valid and infringed. On the question of obviousness, the petition contends that the Eighth Circuit Court of Appeals applied too strict a standard of patentability.

Case Number 37, *Calmar, Inc.* v. *Cook Chemical Co.*, and Case No. 43, *Colgate-Palmolive Co.* v. *Cook Chemical Co.*, represent only a single petition before this Court and is a petition from a decision of the same Eighth Circuit Court of Appeals. In this instance, the petition is from a holding that the patent in suit was valid and infringed and, contra to Case Number 11, the petition on the proper standard of patentability contends that this Court should correct the "drift to lax standards" of Eighth Circuit Court of Appeals.

In Case Number 55, *United States* v. *Adams et al.*, the petition is from a decision of the Court of Claims holding the patent valid and infringed. Again as in Number 37 and 43, the petition to this Court is to correct a "debasement" in the standard of patentability applicable to patents.

The circumstances present in the cases for which petitions for Writ of Certiorari were granted are not present here. There is no conflict in decisions between Courts. There is no holding of validity of the patent involved but rather only holdings by both the District Court and the Court of Appeals that the patent is invalid after full hearings on the question of obviousness and the applicable standard of patentability. Above all, even though the petition were to be granted, any standard of patentability adopted by this Court, high or low, would merely result in the same holding of invalidity that has already prevailed twice before in view of the obvious appropriation and adoption by the alleged inventor of the work of others.

Respondent respectfully contends that, for the reasons given, the petition for a writ of certiorari should be denied.

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